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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,957	02/21/2007	Jayaseelan Daniel Doni	292702US0X PCT	1473

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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NGUYEN, CAM N

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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10/28/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/582,957	DANIEL DONI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cam N. Nguyen	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07/22/09 (an election).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 47-94 is/are pending in the application.
- 4a) Of the above claim(s) 81-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/14/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### **Response to Election/Restrictions**

1. Applicant's election with traverse of Group I, claims 47-80, in the reply filed on 07/22/09 is acknowledged. The traversal is on the ground(s) that "*the Office did not provide any indication of considering the contribution of each invention, as a whole, in alleging the lack of a special technical feature .....Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.*" (Applicants' response page 3) This is not found persuasive because of the following reasons.

It is considered that there is no corresponding special technical feature between Group I and the Group II inventions because the ceramic body of Group I is unpatentable or not novel over US Pat. 6,858,563 B2 and prior art references cited on PTO-892 Form attached. The corresponding special technical feature exists only when the ceramic body is novel. In any event, in accord with the MPEP rule, once the elected product claims are found allowable, the nonelected process claims dependent therefrom will automatically be rejoined with the allowable claims. For purpose of search and examination on the merits, and to expedite the prosecution process of this application, the restriction must be maintained.

The requirement is still deemed proper and is therefore made FINAL.

### **Status of Withdrawn Claim(s)**

2. Claims 81-94 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 07/22/09.

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**Specification**

3. The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical, and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any further amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of the copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

**Claim Objections**

4. Claims 47-50 are objected to because of the following informalities:

In line 1, “with” should be changed to --having--.

Appropriate correction is required.

**Claim Rejections - 35 USC § 112 (Second Paragraph)**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 47 & 49-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A. Claims 47 & 49 recite “the ceramic particles” in line 2. There is insufficient antecedent basis for this limitation in the claim.

B. Regarding claims 49 & 50, last three lines, the phrase “wherein at least one selected from pores and elements capable of directly supporting a catalyst component is present on the surface of the ceramic particles” is unclear as to what applicants intend. Thus, renders the claims vague and indefinite.

C. Claims 75-80 recite the limitation “the ceramic catalyst body” in line 1. There is insufficient antecedent basis for this limitation in the claim.

### **Double Patenting**

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 47-80** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-35 of copending Application No. US**

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**2006/0178265 A1 (or Appl. Serial No. 11/340,542).** Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

The substantive difference between the instant claims and the disclosed claims, is that the disclosed claims further recite the limitation “the needle-shaped ceramic particles compose of a tip having a spherical shape and a body portion that supports the tip, and the diameter of the tip having a spherical shape is larger than the diameter of the body portion”, which the instant claims do not recite.

It is inherent and expected that the claimed ceramic body would have the same characteristics as in the disclosed ceramic body because both the instant claims and the disclosed claims recite the same ceramic body, wherein at least a portion of the ceramic particles contains at least Si, Al, and Mg and has needle-shaped crystal structure. In other words, the needle-shaped crystal structure of the claimed ceramic body would inherently have “the needle-shaped ceramic particles compose of a tip having a spherical shape and a body portion that supports the tip, and the diameter of the tip having a spherical shape is larger than the diameter of the body portion” as recited in the disclosed claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claim Rejections - 35 USC § 102(e)**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 47-80** are rejected under 35 U.S.C. 102(e) as being anticipated by Suzawa et al., hereinafter referred to as “***Suzawa '563***”, (US Pat. 6,858,563 B2).

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

***Suzawa '563*** appears to teach the claimed ceramic body and ceramic catalyst body containing at least Si, Al, and Mg and having the claimed catalytic structure (see col. 12, claim 1 thru col. 14, claim 19). See also entire reference for further details.

There is no patentable distinction seen between the claimed ceramic body and ceramic catalyst body, and those disclosed by ***Suzawa '563***, thus anticipates the instant claims.

### **Citations**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared attached.

### **Conclusion**

9. Claims 47-94 are pending. Claims 47-80 are rejected. Claims 81-94 are withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

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**Contacts**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner CAM N. NGUYEN, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Primary Examiner

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/C. N. N./

October 22, 2009